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## FACSIMILE TRANSMITTAL SHEET

TO: Central Facsimile Number for Official Patent-Related Correspondence (Examiner Mooneyham, Janice A.)	FROM: Randy Calhoun
COMPANY: U.S. Patent and Trademark Office	DATE: February 16, 2007
FACSIMILE NO: 1-571-273-8300	TOTAL NO. OF PAGES INCLUDING COVER:
RE: Application Serial No.: 09/825,470 First Named Inventor: Lawrence, David Group Art Unit: 3629 Atty. Ref. No.: G08.127	SENDER'S TELEPHONE No: 203-972-5985

## CERTIFICATE OF FACSIMILE UNDER 37 CFR 1.8

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By:   
Randolph P. Calhoun

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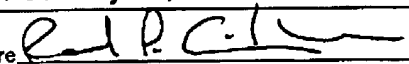

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>G08.127</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 16, 2007</u> Signature <u></u> Typed or printed name <u>Randolph P. Calhoun</u>		Application Number <u>09/825,470</u> Filed <u>04/02/2001</u> First Named Inventor <u>Lawrence, David</u> Art Unit <u>3629</u> Examiner <u>Mooneyham, Janice A.</u>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).            Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>45,371</u>		<div style="text-align: center;">             Signature  <u>Randolph P. Calhoun</u>            Typed or printed name  <u>(203) 972-5985</u>            Telephone number  <u>February 16, 2007</u>            Date         </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: JONES ET AL.

Application No.: 09/825,470

Filing Date: April 2, 2001

For: **AUTOMATED LEGAL ACTION  
RISK MANAGEMENT**

) Group Art Unit: 3629  
)  
) Examiner: MOONEYHAM, Janice A.  
)  
) **REASON(S) FOR REQUESTING A PRE-  
APPEAL BRIEF REVIEW**  
)  
) Attorney Docket No.: G08.127  
)  
) **PTO Customer Number 28062**  
) Buckley, Maschoff & Talwalkar LLC  
) Attorneys for Intel Corporation  
) 50 Locust Avenue  
) New Canaan, CT 06840  
)

***CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8***

I hereby certify that this correspondence is transmitted by facsimile to the United States Postal Service to: (571) 273-8300, on February 16, 2007.

Dated: February 16, 2007

By:

  
Randolph P. Calhoun

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action mailed October 19, 2006 and the Advisory Action dated January 19, 2007, Applicant respectfully requests a panel review for the reason(s) that begin on page 2 of this paper.

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### **REASON(S) FOR REQUESTING A PRE-APPEAL BRIEF REVIEW**

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 are in the application. Claims 1, 16, and 20 are the independent claims herein.

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 stand finally rejected under 35 U.S.C. 112, 1<sup>st</sup> paragraph, as failing to comply with the enablement requirement; rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as being indefinite; rejected under 35 U.S.C. 101 for allegedly being directed to non-statutory subject matter; and rejected under 35 USC 103(a) as being unpatentable over Heckman et al., U.S. Patent No. 5,875,431 (hereinafter, Heckman) in view of Halligan et al., US Pat. App. No. 2002/0077941 (hereinafter, Halligan).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the final rejection.

#### **I. Claim Rejections – 35 USC 112, 1<sup>st</sup> paragraph**

Applicant notes that the Examiner admits at page 3 of the Final Office Action dated October 19, 2006 (referred to herein as the FOA) that the Specification explicitly states one exemplary way to implement the invention. The Examiner also restates the specifically claimed operations of claim 1, including the calculating of the plurality of risk assessment values, the calculating of a risk quotient, and the generation of a suggested action in response to the calculated risk quotient.

Applicant respectfully submits that the Specification, including the portions cited by the Examiner, clearly illustrate that the Specification is in compliance with 35 SC 112, 1<sup>st</sup> paragraph. The exemplary manner of practicing the invention provided in the Specification (admitted as such by the Examiner) is enabling with respect to the invention claimed by Applicant, as stated at page 7 of AF Response dated December 19, 2007 (referred to herein as the AF Response).

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Further, those skilled in the pertinent arts related to the claimed subject matter to which the application pertains would/do understand how to assign a numerical value to a factor of a computer-implemented method since such task(s) are understood by those knowledgeable in, for example, computer programming and/or analysis. Assigning values to a defined variable of a computer-implemented method is submitted as well-known and need not be repeated or explained by Applicants in view of the scope of the pending claims.

As stated in the AF Response at page 8, Applicant claims require calculating by multiply and calculating by summing, as disclosed in the explicit example of the Specification. The calculating operations of the claims and the explicit example do not require any subjective analysis of values, instead they recite mathematical calculating operations.

Referring the paragraphs [0045] – [0047] of the Specification, Applicant notes that the Specification discloses a concrete result obtained by the disclosed and claimed method. Namely, the Specification discloses generating a suggested action in response to the calculated risk quotient. Applicant submits that the suggested action generated in response to the calculated risk quotient is a concrete result that can be repeated by, for example, performing the invention as detailed in the explicit example in the Specification. Furthermore, the result (i.e., the generated suggested action) is repeatable. Applicant respectfully notes that a result will be obtained each time the explicit example process of the Specification is performed, as recited in the claims.

Therefore, Applicant respectfully submits that the Specification is in fact enabling.

## **II. Claim Rejections - 35 U.S.C. 112, 2<sup>nd</sup> paragraph**

The Examiner sought clarification regarding what numerical values and who assigns the numerical value to the risk assessment factors in arguing the rejection of the claims under 35 USC, 2<sup>nd</sup> paragraph. As explained at page 9, paragraph 7 – page 10, paragraph 5 of the AF Response, “who” assigns the numerical value is not relevant

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to the claimed method and what specific "values" assigned to the variable risk assessment values are not necessary or required in view of the scope of the pending claims.

Accordingly, Applicant respectfully submits that the claims do in fact distinctly claim the subject matter Applicant regards as the invention.

### **III. Claim Rejections - 35 U.S.C. 101**

Applicant respectfully submits that the claimed invention is (1) within the technological arts and (2) the claimed invention produces a useful, concrete, and tangible result (e.g., provide a suggested action associated with the legal action). Applicant's previous rebuttal to this rejection may be found in the AF Response at page 10, paragraphs 1 – 3.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 101.

### **Claim Rejections – 35 USC § 103**

Applicant respectfully submits that the combination of Heckman and Halligan fail to render Applicant's claims obvious under 35 USC 103(a).

Regarding claims 1, 16, and 20, Heckman was cited and relied upon for disclosing a computer implemented method, system, and program code for managing risk related to a legal action, including a computer system comprising a computer server; receiving, into a computer memory, information relating to a plurality of risk assessment factors associated with legal actions; and generating a suggested action. Halligan was cited and relied upon for disclosing assigning a numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors; calculating a plurality of risk factor values by multiplying the numerical value and the

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weight assigned to each of the plurality of risk assessment factors; and calculating a risk quotient for the legal action by summing the plurality of risk factor values.

That is, Heckman discloses a system and method that does not assign numerical values, assign weights, calculate risk factor values by multiplying the numerical value and the weight assigned to the risk assessment factors, and calculate a risk quotient for the legal action by summing the plurality of risk factor values. The entire detailed method and system of Heckman does not include or suggest assigning numerical values, assigning weights, calculating risk assessment factor values by multiplying numerical values and weights, and calculating a risk quotient for the legal action that is analyzed and evaluated by Heckman. In fact, the Heckman process does not rely on or suggest the use of assigned and/or calculated numerical values relating to any of the many types of data used therein.

Halligan however discloses,

In the United States, Section 757 of the First Restatement of Torts set forth six factors for evaluating the existence of a trade secret to assist the courts in adjudicating trade secret cases. One of the inventions we claim is a method of using the six factors to document, weight, and evaluate the existence of a trade secret and measures to protect the trade secret. (emphasis added) (Halligan, para. [0009])

Thus, it is clear that the six factors regarding a trade secret are used to document, weight, and "evaluate the existence of a trade secret and measures to protect the trade secret". The numerical factors disclosed in Halligan, whether assigned or calculated, each relate to the merits of a trade secret and measures to protect (i.e., maintain) the trade secret. While the factors disclosed in Halligan may mirror those used in a court in assessing the existence of a trade secret in a trade secret legal proceeding, the factors themselves are related to the existence (or not) of the trade secret, not a legal action.

Combining Heckman and Halligan as argued by the Examiner would appear to logically result in the legal strategic planning and evaluation system of Heckman regarding a legal proceeding (lacking any assigning and calculating of numerical values) that uses the Halligan disclosed method of documenting, analysis, auditing,

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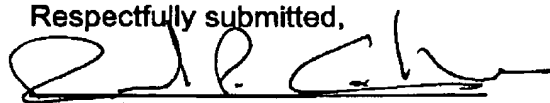
accounting, protecting, registering, and verifying of trade secrets. That is, the asserted combination would be a legal analysis system that does not assign or calculate any numerical values to generate a suggested legal action associated with a legal action (disclosed by Heckman) and that uses the trade secret evaluation and analysis method and system to assign numerical values in evaluating trade secrets (as disclosed by Halligan). Even expanding the legal action to those not involving trade secrets (e.g., criminal or malpractice cases), the cited and relied upon combination of references suggest that the evaluation of the underlying subject matter (e.g., criminal or malpractice cases) be evaluated by assigning numerical values as disclosed in Halligan but the overall legal matter be analyzed per Heckman (i.e., no numerical values).

Therefore, it is clear that even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the patentable differences between the claims and the combination of Heckman and Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 6-9, 11-15, 17-19, and 24-27 depend from claims 1, 16, and 20. It is further submitted that all of the pending claims 1, 2, 6-9, 11-20, and 24-27 are patentable over Heckman and Halligan under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1 – 33 under 35 USC 103(a). If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

February 16, 2007  
Date

Respectfully submitted,



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